

Application Number 09/781,605
Amendment dated 27 October 2005
Reply to Office Action of 27 May 2005

Remarks

Applicants have not cancelled any claims in this Reply, and have added new dependent Claims 18 and 19. Therefore, Claims 1, 3–6 and 9–19 are now pending in this Application.

Claim Rejections Under 35 U.S.C. § 103(a) based on Teshima, Zubeldia and Clark.

Claims 1, 3–6 and 9–12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent 6,272,470 ("Teshima"), U.S. Patent 6,397,224 ("Zubeldia") and U.S. Patent 6,149,440 ("Clark"). Claims 3–5 depend from independent Claim 1. Claims 9–11 depend from independent Claim 6. Claim 12 is independent.

Teshima discloses an electronic clinical recording system capable of handling an electronic record of a patient's history of medical consultations (see Teshima abstract). When a patient visits a healthcare service provider for medical consultation, a record of the consultation information, such as main complaint, findings, name of disease and orders, is recorded onto a patient card (see Teshima Figure 6, boxes 108 and 109). The patient can then retain the patient card and present it at subsequent medical consultations, thereby providing a medical history for the patient (see Teshima at 3:27–37). Zubeldia discloses a system capable of anonymously linking a plurality of data records; the system is capable of accepting data entry of an individual's personal information to form a data record (see Zubeldia at 1:7–9 and 5:26–33). Clark discloses a system for presenting information to an individual, and authenticating that individual's receipt and comprehension of the information (see Clark at 2:66–3:3). The system is capable of generating a video record of the individual receiving the information, as well as of the individual responding to questions regarding the information (see Clark at 6:63–7:16).

Claims 1 and 3–5. In contrast to the combined disclosure of Teshima, Zubeldia and Clark, Claim 1 recites, among other things,
a database management server comprising:

Application Number 09/781,605
Amendment dated 27 October 2005
Reply to Office Action of 27 May 2005

a database including a plurality of fields of personal data relating to a patient and
an optical disk writer wherein the optical disk writer writes a patient record that includes selected fields of the personal data to the portable optical disk, said selected fields of the personal data being viewable and downloadable by the subscriber computer, and wherein said selected fields of personal data are chosen by the patient from the plurality of fields of personal data

The Examiner has conceded that neither Teshima nor Zubeldia teach a system wherein "selected fields of personal data are chosen by the patient from the plurality of fields of personal data". Instead, the Examiner relies upon Clark as teaching this element, referring specifically to 6:63–7:56 of Clark. Applicants respectfully disagree with the Examiner's characterization of Clark as teaching this element.

As explained above, Clark discloses a system for presenting information to an individual, and authenticating that individual's receipt and comprehension of the information. In the specific embodiment of the Clark system to which the Examiner refers, a visual record is created of the individual receiving the information, being tested on the information, and providing a signature (see Clark at 6:19–23 and Figure 1, box 24). The visual record of the individual is archived on a storage medium, along with other information such as test questions, the individual's responses to test questions, and the individual's signature (see Clark at 6:63–7:16).

Significantly, Clark contains no teaching of a system wherein an optical disk writer "writes a patient record that includes selected fields of the personal data to the portable optical disk ... wherein said selected fields of personal data are chosen by the patient from the plurality of fields of personal data" (emphasis added), as is recited in Claim 1. Indeed, adding this element to the Clark system would defeat many purposes of the Clark system, including (a) "making a consolidated, correlated non-erasable, tamper-resistant record" of the giving of an informed consent (see Clark at 14:67–15:3; emphasis added); and (b) providing a permanent record of an informed consent, "including the ability to authenticate the integrity of the record (see Clark at 15:27–34; emphasis added). Thus, not only does Clark completely fail to teach the elements of Claim 1 as asserted by the Examiner, but it would be completely counterintuitive to modify the Clark system to include the elements recited in Claim 1.

Application Number **09/781,605**
Amendment dated **27 October 2005**
Reply to Office Action of **27 May 2005**

Based on the foregoing, Applicants submit that the combination of Teshima, Zubeldia and Clark does not render unpatentable Claim 1, and therefore respectfully suggest that Claim 1 is in condition for allowance. Furthermore, because Claims 3–5 depend from Claim 1, Applicants submit that Claims 3–5 are allowable over Teshima, Zubeldia and Clark for the same reasons that Claim 1 is allowable.

Claims 6 and 9–11. In contrast to the combined disclosure of Teshima, Zubeldia and Clark, Claim 6 recites, among other things,

writing a patient record onto a portable optical disk via the optical disk writer wherein the portable optical disk is readable from an optical disk drive using the Internet web browser interface, and wherein the patient record includes selected fields of the personal data that are chosen by the patient from the plurality of fields

The Examiner has conceded that neither Teshima nor Zubeldia teach a method that includes writing a patient record onto a portable optical disk, wherein “the patient record includes selected fields of the personal data that are chosen by the patient from the plurality of fields”. Instead, the Examiner relies upon Clark as teaching this element, referring specifically to 6:63–7:56 of Clark. Applicants respectfully disagree with the Examiner’s characterization of Clark as teaching this element.

As explained above, Clark discloses a system for presenting information to an individual, and authenticating that individual’s receipt and comprehension of the information. In the specific embodiment of the Clark system to which the Examiner refers, a visual record is created of the individual receiving the information, being tested on the information, and providing a signature (see Clark at 6:19–23 and Figure 1, box 24). The visual record of the individual is archived on a storage medium, along with other information such as test questions, the individual’s responses to test questions, and the individual’s signature (see Clark at 6:63–7:16).

Significantly, Clark contains no teaching of a method that includes writing a patient record onto a portable optical disk, wherein “the patient record includes selected fields of the personal data that are chosen by the patient from the plurality of fields” (emphasis added), as is recited in Claim 6. Indeed, adding this element to the Clark system would defeat many purposes of the Clark system, including (a) “making a consolidated, correlated non-erasable, tamper-resistant record” of the giving of an

Application Number **09/781,605**
Amendment dated **27 October 2005**
Reply to Office Action of **27 May 2005**

informed consent (see Clark at 14:67–15:3; emphasis added); and (b) providing a permanent record of an informed consent, “including the ability to authenticate the integrity of the record (see Clark at 15:27–34; emphasis added). Thus, not only does Clark completely fail to teach the elements of Claim 6 as asserted by the Examiner, but it would be completely counterintuitive to modify the Clark system to include the elements recited in Claim 6.

Based on the foregoing, Applicants submit that the combination of Teshima, Zubeldia and Clark does not render unpatentable Claim 6, and therefore respectfully suggest that Claim 6 is in condition for allowance. Furthermore, because Claims 9–11 depend from Claim 6, Applicants submit that Claims 9–11 are allowable over Teshima, Zubeldia and Clark for the same reasons that Claim 6 is allowable.

Claim 12. In contrast to the combined disclosure of Teshima, Zubeldia and Clark, Claim 12 recites, among other things,

entering means for entering personal data into a patient record, the personal data being organized into a plurality of fields;

storing means for storing selected fields of the personal data in a uniformly accessible manner on an optical disk, wherein the selected fields of personal data are selected by the patient

The Examiner has conceded that neither Teshima nor Zubeldia teach a system wherein “personal data [is] organized into a plurality of fields”. Furthermore, the Examiner has failed to present any argument or evidence that Teshima, Zubeldia or Clark teach “storing means for storing selected fields of the personal data in a uniformly accessible manner on an optical disk, wherein the selected fields of personal data are selected by the patient” (emphasis added), as is recited in Claim 12. Therefore, Applicants submit that the combination of Teshima, Zubeldia and Clark does not render unpatentable Claim 12, and therefore respectfully suggest that Claim 12 is in condition for allowance.

Claim Rejections Under 35 U.S.C. § 103(a) based on Teshima and Feinberg.

Claims 13–17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Teshima and U.S. Patent 6,415,295 (“Feinberg”). Claim 13 is

Application Number 09/781,605
Amendment dated 27 October 2005
Reply to Office Action of 27 May 2005

independent. Claims 15 and 16 depend from independent Claim 14. Claim 17 depends from independent Claim 1.

Feinberg discloses a system for storing personal medical information (see Feinberg at 4:7-13). The information is stored on an apparatus that includes human readable characters and/or machine readable characters, such as a bar code (see Feinberg Figure 1A and 4:7-13 and 6:15-16). The purpose of the Feinberg system is to provide a means for communicating a personal medical history to a point of care (see Feinberg at 4:22-26). The Feinberg apparatus includes personal medical history information such as demographic information, prior surgical history, current medications, and a host of other types of patient-specific information (see Feinberg at 4:45-51).

Claim 13. In contrast to the disclosure of Teshima and Feinberg, amended Claim 13 recites a portable optical disk comprising, among other things, generic data related to a healthcare facility, wherein

the generic data is stored in a uniformly accessible manner and comprises physician information, healthcare facility information, and an Internet hyperlink in formats including text, images, audio and video;

The Examiner has conceded that Teshima does not teach an optical disk that includes "generic data". Likewise, Feinberg does not teach an optical disk that includes "generic data", since Feinberg's teachings are limited to patient-specific information, as explained above.

Faced with the deficiencies in the teachings of Teshima and Feinberg, the Examiner has taken the position that it would be obvious to modify Teshima such that the optical disk includes generic data comprising "physician information, healthcare facility information, and an Internet hyperlink". However, to establish that it would be obvious to modify the teachings of the prior art, the Examiner must point to some teaching, suggestion, or motivation to make such a modification; the Examiner may rely on the explicit or implicit teachings of the prior art references themselves, or on the knowledge generally available to one of ordinary skill in the art (see MPEP 2143.01(I)).

Here, the Examiner has taken the position that her proposed modification of Teshima would be obvious because Feinberg "allows access to medical information in

Application Number **09/781,605**
Amendment dated **27 October 2005**
Reply to Office Action of **27 May 2005**

case of emergency". Even assuming this is true—Applicants note that the cited passage mentions nothing of emergency access—the fact remains that Feinberg's teachings are limited to patient-specific information, as opposed to generic information. Thus, Applicants respectfully submit Feinberg cannot supply any suggestion to include generic data on the optical disk in view of the fact that Feinberg contains absolutely no teaching of generic data whatsoever.

Moreover, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification (see MPEP 2143.01(V.)). As expounded above, the purpose of the Feinberg invention is to provide mobile access to a patient's medical history information (see Feinberg at 4:22–26). Not only would inclusion of generic data do nothing to serve this purpose, it would have the disadvantage of reducing the amount of storage capacity available on the Feinberg apparatus for storing the patient-specific information. Notably, Feinberg discloses a rather complex algorithm for compressing data to maximize the amount of patient-specific information that can be included on the apparatus. Thus, in view of Feinberg's teachings, it would certainly be counterintuitive to include generic data on the apparatus. Thus, Feinberg actually teaches away from including generic data.

Based on the foregoing, Applicants submit that the combination of Teshima and Feinberg does not render unpatentable amended Claim 13, and therefore respectfully suggest that amended Claim 13 is in condition for allowance.

Claims 14–16. In contrast to the disclosure of Teshima and Feinberg, amended Claim 14 recites a portable optical disk comprising, among other things:

generic data stored in a uniformly accessible manner wherein the generic data includes physician information, healthcare facility information, and an Internet hyperlink

The Examiner has conceded that Teshima does not teach an optical disk that includes "generic data". Likewise, Feinberg does not teach an optical disk that includes "generic data", since Feinberg's teachings are limited to patient-specific information, as explained above.

Faced with the deficiencies in the teachings of Teshima and Feinberg, the Examiner has taken the position that it would be obvious to modify Teshima such that

Application Number **09/781,605**
Amendment dated **27 October 2005**
Reply to Office Action of **27 May 2005**

the optical disk includes generic data comprising "physician information, healthcare facility information, and an Internet hyperlink". However, to establish that it would be obvious to modify the teachings of the prior art, the Examiner must point to some teaching, suggestion, or motivation to make such a modification; the Examiner may rely on the explicit or implicit teachings of the prior art references themselves, or on the knowledge generally available to one of ordinary skill in the art (see MPEP 2143.01(I.)).

Here, the Examiner has taken the position that her proposed modification of Teshima would be obvious because Feinberg "allows access to medical information in case of emergency". Even assuming this is true—Applicants note that the cited passage mentions nothing of emergency access—the fact remains that Feinberg's teachings are limited to patient-specific information, as opposed to generic information. Thus, Applicants respectfully submit Feinberg cannot supply any suggestion to include generic data on the optical disk in view of the fact that Feinberg contains absolutely no teaching of generic data whatsoever.

Moreover, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification (see MPEP 2143.01(V.)). As expounded above, the purpose of the Feinberg invention is to provide mobile access to a patient's medical history information (see Feinberg at 4:22–26). Not only would inclusion of generic data do nothing to serve this purpose, it would have the disadvantage of reducing the amount of storage capacity available on the Feinberg apparatus for storing the patient-specific information. Notably, Feinberg discloses a rather complex algorithm for compressing data to maximize the amount of patient-specific information that can be included on the apparatus. Thus, in view of Feinberg's teachings, it would certainly be counterintuitive to include generic data on the apparatus. Thus, Feinberg actually teaches away from including generic data.

Based on the foregoing, Applicants submit that the combination of Teshima and Feinberg does not render unpatentable amended Claim 14, and therefore respectfully suggest that amended Claim 14 is in condition for allowance. Furthermore, because

Application Number 09/781,605
Amendment dated 27 October 2005
Reply to Office Action of 27 May 2005

Claims 15 and 16 depend from Claim 14, Applicants submit that Claims 15 and 16 are allowable over Teshima and Feinberg for the same reasons that Claim 14 is allowable.

Claim 17. Claim 17 depends from Claim 1, which currently stands rejected as unpatentable over the combination of Teshima, Zubeldia and Clark. Because Feinberg does not remedy the deficiencies of Teshima, Zubeldia and Clark, Applicants respectfully submit that Claim 17 is allowable for at least the same reasons that Claim 1 is allowable.

New Claims 18 and 19.

New Claim 18 depends from independent Claim 13, and recites an element which has been removed from independent Claim 13. Therefore, new Claim 18 contains no new matter. Distinctions between Claim 13 and the cited references are specifically discussed herein. Because new Claim 18 depends from Claim 13, and further distinguishes the claimed invention from the cited references, Applicants submit that new Claim 18 is allowable over the cited references for at least the same reasons that Claim 13 is allowable over the cited references.

New Claim 19 depends from independent Claim 14, and recites an element which has been removed from independent Claim 14. Therefore, new Claim 19 contains no new matter. Distinctions between Claim 14 and the cited references are specifically discussed herein. Because new Claim 19 depends from Claim 14, and further distinguishes the claimed invention from the cited references, Applicants submit that new Claim 19 is allowable over the cited references for at least the same reasons that Claim 14 is allowable over the cited references.

Conclusion.

Applicants respectfully submit that the claims are in condition for allowance. Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse

Application Number 09/781,605
Amendment dated 27 October 2005
Reply to Office Action of 27 May 2005

each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter. If some issue remains that the Examiner feels can be addressed by an Examiner's Amendment, the Examiner is cordially invited to call the undersigned for authorization.

Respectfully submitted,

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